

## **REMARKS**

### ***AMENDMENT TO THE CLAIMS***

The elements of claim 4 have been incorporated into claim 1. The elements of claim 14 have also been incorporated into claim 1. Thus, claim 1 now encompasses the subject matter previously recited with respect to claims 1, 4, and 14 (each of the latter depending on the former). No further search is necessitated through this amendment in that all claim limitations were previously searched albeit in the context of one independent (1) and two separate (albeit related) dependent claims (4 and 14). As such, a final rejection based on the present amendment is not warranted.

Claims 11-13 have been cancelled; the Applicants reserve the right to pursue the cancelled subject matter in a continuation application. This cancellation is not made with respect to the merits of any rejection posited by the Examiner. This cancellation is made solely to facilitate examination and focus of the issues remaining for disposition before appeal should allowance not be forthcoming in a subsequent action.

Other cosmetic amendments have been made for the purpose of maintaining antecedent basis or consistency of claim terminology throughout the body of the claim. None of these amendments warrant a further search.

**35 U.S.C. § 103(A) REJECTION**

The Examiner contends that the combination of U.S. patent number 5,634,053 to Noble et al., U.S. patent number 7,213,262 to Elley et al., and U.S. patent number 5,115,501 to Kerr discloses the subject matter of previously pending claims 1, 4, and 14. See *Office Action*, 3-5 and 9-10. The Applicants contend that one skilled in the art would not have been motivated to make the present combination, especially with respect to the Kerr reference.

Kerr concerns a purported “application program [that] automatically creates and presents a customized user interface.” *Kerr*, Abstract. Kerr purports to create and present this interface by “determining a set of operations which is appropriate for the current user based on various relevant characteristics of the user.” *Id.* As a result, “[t]he application program presents only the specified operations in the menus, icons, application bars or other interface components of the application program.” As an initial matter, the Applicants contend that one skilled in the art would not seek to combine the teachings of user interface creation and generation (Kerr) in the context of the credential and membership disclose of Elley et al. and the smart dictionaries, data information managers, and local information managers referenced in Noble et al. The Applicants further question whether one would make the aforementioned use of the UI teachings of Kerr in an effort to arrive at the presently claimed ‘apparatus for providing information in response to a query of a virtual database table’ as set forth in claim 1.

When applying 35 U.S.C. 103(a), the following tenets of patent law must be adhered to:

(A) The claimed invention must be **considered as a whole**; (B) The **references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination**; (C) The references must be **viewed without the benefit of impermissible hindsight** vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. See

*Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). The Applicants respectfully suggest that the references and the presently claimed invention have not been considered as a whole in light of the aforementioned combination of references. In that regard, the Applicants respectfully contend that a *prima facie* case of obviousness has not been made and that the rejection is overcome.

Notwithstanding, the Examiner contends that “[i]t would have been obvious to one of ordinary skill in the art . . . to modify the above combination” to include “an additional information source that is a user profile information source,” wherein “the manner of selecting [a] row includes profile gathering information,” and “the provided information is obtained at least in part from the profile information source.” *Office Action*, 9-10. The Examiner’s motivation, however, is nothing more than a summary of the claimed subject matter of former claim 14 (now a part of claim 1). The Applicants challenge the purported motivation to combine in that the Examiner has failed to identify any particular teaching in the cited references or that *is actually known* to one of ordinary skill in the art to make the purported combination. The Examiner relies on nothing more than the Applicants’ claimed invention.

The Applicants appreciate that “[t]he rationale to modify or combine the prior art does not have to be expressly stated in the prior art” and that “the rationale . . . may be reasoned from knowledge generally available to one of ordinary skill in the art.” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). That said, a statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art “because the references relied upon teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a *prima facie* case of obviousness without some **objective reason to combine the teachings of the references.**” *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (emphasis added). The Supreme Court re-affirmed the same in *KSR International Co. v. Teleflex Inc.* wherein the court found that “rejections on obviousness cannot be sustained by **mere**

**conclusory statements**; instead, there must be some **articulated reasoning** with some **rational underpinning** to support the legal conclusion of obviousness.” 550 USPQ2d 1385, 1396 (2007) (emphasis added); see also *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Absent such objective articulated reasoning and some rational underpinning related to the same, the Applicants contend that a *prima facie* case of obviousness has not been and that the Examiner’s rejection is overcome.

#### ***DEPENDENT CLAIMS***

Each and every one of the dependent claims of the present application depends either directly from—or via another dependent claim that ultimately depends from—claim 1 of the present application. A dependent claim incorporates each and every limitation of the claim from which it depends under 35 U.S.C. § 112, ¶ 4. The Applicants therefore contend that all dependent claims are allowable for at least the same reasons as claim 1.

## CONCLUSION

The Applicants have evidenced the lack of a motivation to combine Noble, Elley, and Kerr. Absent said motivation, a *prima facie* case of obviousness is lacking and the Examiner's 35 U.S.C. § 103(a) rejection is overcome.

The Applicants respectfully request the passage of the present application to allowance. The Examiner is invited to contact the undersigned with any questions concerning this amendment or the overall state of this application.

Respectfully submitted,  
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July 22, 2008

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